

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/440,903

11/16/99

BENNETT

P PACFI-001C1

007663 QM12/0316
STETINA BRUNDA GARRED & BRUCKER
24221 CALLE DE LA LOUISA 4TH FLR
LAGUNA HILLS CA 92653-3642

EXAMINER

CRONIN, S

ART UNIT	PAPER NUMBER
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3727

DATE MAILED:

03/16/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/440,903	BENNETT, PAUL H.	
	Examiner Stephen K Cronin	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 31-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 31-40 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 November 1999 is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - a) All
 - b) Some *
 - c) None of the CERTIFIED copies of the priority documents have been:
 1. received.
 2. received in Application No. (Series Code / Serial Number) _____.
 3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

14) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	17) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
15) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	18) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
16) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u>	19) <input type="checkbox"/> Other: _____

Art Unit: 3727

DETAILED ACTION

Drawings

1. The drawings are objected to because the cross sections of figures 2, 3, 5-9, 13 and 14 contain improper hatching for a showing of the disclosed plastic material from which the closure is made. Correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(f) he did not himself invent the subject matter sought to be patented.

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

2. Claims 31-33 and 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Merolle 2,326,480.

Merolle teaches a closure for a container comprising a container with a neck 15, a shoulder 17, and a screw thread 16, and a closure 1 with an inner cap 6, a seal 24, a screw thread 8, an outer cap 5 joined to the inner cap, a tamper indicating skirt with retaining means 19, rupture lines 21, 22, a tear strip 20 and a tab 23, which is structurally identical to the container and closure recited in the claims.

Art Unit: 3727

3. Claims 31, 33-36 and 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Menke 3,901,403.

Menke teaches a tear open tamper proof closure comprising a container with a neck 11, a shoulder and a screw thread, and a closure 14 with an inner cap 13, a seal and screw threads (not numbered), an outer cap 15a releasable joined to the inner cap, a tamper indicating skirt 15b with retaining means 19, a rupture line 26 and a tear strip with a tab 31 which is structurally identical to the container and closure set forth in the claims.

4. Claims 31-40 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/014,075 which has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application. The status of the inventorship in the current application is unclear. The declaration of the current child application sets forth Paul H. Bennett as the sole inventor. Papers have been filed in the parent 09/014,075 application adding Thom M. Perlmutter as an inventor. The inventive entities are not the same.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the

Art Unit: 3727

copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

5. Claims 31-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Bennett 5,711,443.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

6. Claims 31-40 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The chain of inventorship in the current and parent applications differ.

7. Claims 31-40 are rejected under 35 U.S.C. 102(e) based upon claims 1-42 of Patent No. 5,711,443.

Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is

Art Unit: 3727

copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

5. Claims 31-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Bennett 5,711,443.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

6. Claims 31-40 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The chain of inventorship in the current and parent applications differ.

7. Claims 31-40 are rejected under 35 U.S.C. 102(e) based upon claims 1-42 of Patent No. 5,711,443.

Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is

Art Unit: 3727

the first inventor in this country. See *In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 31-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 5,711,443. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the current application broadly recite the invention patented in the prior parent application.

10. Claims 31-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 31-40 of copending Application No. 09/014075. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the current application broadly recite the claimed invention of the prior parent application.

Art Unit: 3727

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show the current state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen K Cronin whose telephone number is 703-308-4296. The examiner can normally be reached on M-TH 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Stephen K Cronin
Primary Examiner
Art Unit 3727

SKC
March 13, 2000